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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION**

ASETEK DANMARK A/S,

Plaintiff and
Counterdefendant,

ASETEK USA, INC.,

Counterdefendant,

v.

COOLIT SYSTEMS, INC.,

Defendant and
Counterclaimant,

COOLIT SYSTEMS USA INC., COOLIT
SYSTEMS ASIA PACIFIC LIMITED,
COOLIT SYSTEMS (SHENZHEN) CO.,
LTD.,

Defendants,

CORSAIR GAMING, INC. and CORSAIR
MEMORY, INC.,

Defendants.

CASE NO. 3:19-cv-00410-EMC

**ASETEK DANMARK A/S AND ASETEK
USA, INC.'S REPLY IN SUPPORT OF
MOTION FOR PARTIAL SUMMARY
JUDGMENT**

Date: May 5, 2022
Time: 1:30 PM
Location: Courtroom 5, 17th Floor
Judge: Hon. Edward M. Chen

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I. THE CLAIMED “PLATE” SHOULD BE CONSTRUED TO REQUIRE A RIGID MATERIAL BASED ON THE INTRINSIC RECORD AND THE PTAB’S FINAL DECISION

Instead of directly addressing the merits of Asetek’s proposed construction of “plate,” CoolIT primarily raises a procedural argument that Asetek’s request for claim construction should be ignored as “untimely.” CoolIT asks this Court to disregard the final judgment of the PTAB which drove Asetek’s claim construction request, and to give “plate” a plain and ordinary meaning in spite of the PTAB’s finding that there is no written description support for plate made of compliant materials. CoolIT’s procedural arguments are contrary to the law and facts in this case, as well as hypocritical given that CoolIT similarly requested claim construction after a PTAB ruling on one of its patents (explained below). CoolIT’s reliance on extrinsic evidence that are at odds with intrinsic evidence to argue that the material of the “plate” is unimportant is also misplaced.

A. The PTAB’s Final Written Decision in the IPR Against CoolIT’s ’266 Patent Led to Asetek’s Request for Claim Construction

CoolIT’s opposition argues that their infringement theories always mapped the compliant EPDM manifolds in Asetek’s Gen 5, 6, and 7 products to the claimed “plate,” and that Asetek did not supplement its interrogatory responses to identify the non-infringement position based on “plate” before the close of fact discovery on August 31, 2021. Dkt. 423 at 2-3. CoolIT’s arguments ignore that the PTAB’s final written decision discussing written description support for plate did not issue until October 12, 2021—i.e., close to 1.5 months after close of fact discovery—and almost a month after the parties exchanged initial expert reports on September 16, 2021.

In the final written decision, the PTAB not only agreed with Asetek that there was no written description support for “manifold body defin[ing] a pair of compliant surfaces” in the 2007 Provisional (see Dkt. 394-5 at 23, 30), the PTAB additionally found the following:

- In discussing disclosure in CoolIT’s 2011 Provisional of the benefits of compliant insert 334 over rigid plate 240, the PTAB stated: ***“This is objective, intrinsic evidence that the inventor, as of 2011, did not consider plate 240 to be made of what he described in the 2011 Provisional as being compliant material.”*** *Id.* at 24-25 (emphasis added).

- 1 • “The inventor’s substitution of the phrase ‘rigid plate’ for the phrase ‘plate 240’ [in the ’266
2 patent] is objective, intrinsic evidence that as of 2012 [when the ’266 patent was filed], *the*
3 *inventor considered plate 240 (which he was contrasting with compliant insert 334) to be*
4 *made of a rigid, rather than compliant, material.*” *Id.* at 26 (emphasis added).
- 5 • “Nothing in the 2007 Provisional would have indicated to a POSITA that *the inventor*
6 *envisioned making plate 240 of a compliant material* in order to perform a gasketing or
7 sealing function.” *Id.* at 28-29 (emphasis added).

8 Despite the PTAB’s above findings that there is no disclosure prior to 2011 of the plate 240
9 (i.e., the “plate”) being made of a compliant material, CoolIT’s expert subsequently mapped the
10 claimed “plate” to the compliant EPDM manifold in Asetek’s Gen 5, 6, and 7 products in his
11 Infringement Report (served November 3, 2021). After Asetek’s counsel studied the PTAB’s above
12 findings and CoolIT’s expert’s Infringement Report, and also consulted with Asetek’s expert (Dr.
13 Tuckerman) regarding same, the need to construe “plate” consistent with the PTAB’s findings first
14 came into focus. Bhattacharyya Decl., ¶7. The papers exchanged by the parties during the IPR trial
15 did not bring to light this claim construction dispute because CoolIT’s IPR papers focused primarily
16 on a legal argument about written description requirement under *Ariad Pharms., Inc. v. Eli Lilly &*
17 *Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) and “blaze marks” (such as seal and bendable
18 tabs) providing written description for compliant plate, not whether plate 240 itself was made of
19 compliant material (or not). *Id.*; see Ex. A, slide 11. Accordingly, Asetek’s main focus during the IPR
20 trial was to counter CoolIT’s meritless legal arguments and scientifically incorrect “blaze mark”
21 positions. Bhattacharyya Decl., ¶7. The PTAB disagreed with CoolIT’s written description arguments
22 and its unscientific positions on the alleged “blaze marks,” and additionally found that there was no
23 indication the inventor possessed “plate” made of a compliant material in 2007 (as summarized in the
24 bullet points above). Accordingly, there is no written description support for “plate” made of
25 compliant material in the 2007 Provisional. Thus, it was the PTAB’s final written decision, CoolIT’s
26 expert’s Infringement Report, and Asetek’s counsel’s discussions of the PTAB’s decision and the
27 Report with Asetek’s expert that led to Asetek’s request for claim construction of “plate.” *See id.*
28 Contrary to CoolIT’s allegations, Asetek did not strategically withhold “plate” from the prior two

1 rounds of claim constructions. *Id.*

2 Nor is Asetek “ambush[ing]” CoolIT with claim construction during summary judgment, as
 3 alleged by CoolIT. *See* Dkt. 423 at 10-11. Following the issuance of the PTAB’s decision and
 4 discussions with Dr. Tuckerman, Asetek promptly disclosed its claim construction and non-
 5 infringement position in Dr. Tuckerman’s Non-Infringement Report served on December 8, 2021.
 6 Dkt. 394-4, ¶¶41-53. Thus, contrary to CoolIT’s allegation, Asetek timely complied with its Rule 26
 7 disclosure obligations by supplementing its non-infringement disclosure “in writing” and “during the
 8 discovery process.” Fed. R. Civ. P. 26(e)(1)(A) (requiring supplementation or correction of discovery
 9 responses “in a timely manner . . . if the additional or corrective information has *not otherwise been*
 10 *made known to the other parties during the discovery process or in writing.*”) (emphasis added). In
 11 response, CoolIT buried its head in the sand—CoolIT’s expert did not supplement his Infringement
 12 Report, nor did he substantively respond to the PTAB’s findings on written description during his
 13 subsequent deposition in January 2022 (even though he admitted during his deposition that he knew
 14 the PTAB disagreed with him). Ex. B at 95:8-96:18. Thus, CoolIT’s complaint that it had “two mere
 15 weeks to marshal arguments and evidence in support of its opposition to” Asetek’s claim construction
 16 and noninfringement arguments is completely groundless. *See* Dkt. 423 at 12. CoolIT has had close to
 17 four months to develop its opposition, and it has been doing so, as evident from CoolIT’s counsel’s
 18 extensive questioning of Asetek’s expert during his deposition regarding the claim term “plate.” *See,*
 19 *e.g.,* Ex. C at 177:14-188:23.

20 **B. Courts Routinely Consider Claim Construction During Summary Judgment**

21 Although Asetek does not believe that its claim construction request is belated under the
 22 circumstances described in the preceding section, Asetek agrees that the Court “retains discretion to
 23 hear belated claim construction arguments.” *Boston Scientific Corp. v. Johnson & Johnson*, 534 F.
 24 Supp. 2d 1062, 1074 (N.D. Cal. 2007); *see also SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d
 25 1278, 1292 (Fed. Cir. 2005). And in this case, Asetek respectfully submits that claim construction of
 26 “plate” has become necessary following the PTAB’s final written decision to resolve the parties’
 27 disputes over alleged infringement and validity, and respectfully requests that the Court construe
 28 “plate” (and not give it plain and ordinary meaning).

Contrary to CoolIT's arguments, a motion for summary judgment is not an improper means to construe disputed claim terms, and courts in this and other districts routinely do so. As another court in this district and the Federal Circuit have explained, "claim construction presents a question of law for the Court to decide. As such, the Federal Circuit has held that claims may be construed by way of a motion for summary judgment." *Aircraft Tech. Publishers v. Avantext, Inc.*, No. C 07-4154 SBA, 2009 WL 3817944, at *3 (N.D. Cal. Nov. 10, 2009) (citing *Gentex Corp. v. Donnelly Corp.*, 69 F.3d 527, 530 (Fed. Cir. 1995) ("Claim interpretation is a question of law amenable to summary judgment.") and *Laitram Corp. v. Morehouse Indus., Inc.*, 143 F.3d 1456, 1462 (Fed. Cir. 1998) (affirming motion for summary judgment on issues of claim construction)) (internal citation omitted); *Stern v. SeQual Techs., Inc.*, 840 F. Supp. 2d 1260, 1266 (W.D. Wash.) (construing a claim term in a summary judgment motion even though that claim term was not raised in the parties' prior joint claim construction statement), *aff'd*, 493 F. App'x 99 (Fed. Cir. 2012); *z4 Techs., Inc. v. Microsoft Corp.*, No. 06-cv-142 (E.D. Tex. Apr. 12, 2006) (construing an additional claim term during jury trial because it had become central to defendant's litigation arguments) *aff'd*, 507 F.3d 1340 (Fed. Cir. 2007); 6 Annotated Patent Digest § 40:63.60 (Westlaw Matthews Treatise on Patent Law) ("Should a summary judgment motion raise an issue of claim construction for a claim term that the court had not previously construed during the claim-construction phase of the case, the court may construe that claim term as part of the summary judgment proceeding.") (citing additional cases).

The facts in the cases cited by CoolIT are readily distinguishable. In particular, in none of those cases did the party requesting claim construction identify any recent event, such as the PTAB's final decision here, that triggered the need for new claim construction. Here, during the Court's prior claim constructions, the PTAB's decision—which is the main thrust of Asetek's proposed claim construction of "plate"—did not even exist. And there are additional distinguishing facts between the present case and those cited by CoolIT. In *Apple, Inc. v. Samsung Elecs. Co.*, for example, the court declined to "complete the Sisyphean task of providing definitive guidance as to a term's plain and ordinary meaning" in part because of "[p]ractical considerations specific to th[at] case." No. 12-CV-00630-LHK, 2014 WL 252045, at *4-5 (N.D. Cal. Jan. 21, 2014). The court explained that it had previously "warned the parties" that "given the fast-approaching [] trial date, the Court would not treat the

summary judgment phase of this case as a chance for the parties to make additional claim construction arguments.” *Id.* at *4. The court additionally noted its prior experience with the particular litigants in that case endlessly making claim construction-related arguments, and that “[r]esolving those disputes has taken on a ‘whack-a-mole’ character, one for which the returns have quickly diminished.” *Id.* Nevertheless, the court concluded that it would “carefully consider” disputes over claim scope even at the summary judgment stage “as ‘part of the infringement analysis, not part of the claim construction.’” *Id.* Specifically, the court explained that “in determining whether an infringement or anticipation argument fits within the plain and ordinary meaning of a term,” the court would review “‘the written description and other parts of the specification,’ as those tools ‘may shed contextual light on the plain and ordinary meaning’”; the court would simply not define the term’s plain and ordinary meaning. *Id.* at *5. Here, in contrast, Asetek is not asking the Court to define the plain and ordinary meaning of “plate”; rather, Asetek has requested claim construction of “plate” under *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008) because of events that transpired in the PTAB (which Asetek could not have known during the claim construction stage).

Similarly, in *Huawei Technologies, Co, Ltd v. Samsung Electronics Co, Ltd.*, the court agreed to consider “the written description and other parts of the specification” for “contextual light” in determining plain and ordinary meaning of claim terms en route to determining the parties’ *Daubert* motions. 340 F. Supp. 3d 934, 947-49, 961 (N.D. Cal. 2018). Lastly, in *Fujifilm Corp. v. Motorola Mobility LLC*, the court noted that “[t]he parties’ only disagreement concerns whether, in deciding [the summary judgment] motion, [the court] must decide precisely what [the] plain and ordinary meaning” of certain claim terms are. No. 12-CV-03587-WHO, 2015 WL 757575, at *4-5 (N.D. Cal. Feb. 20, 2015). That is not the case here. Asetek is not asking the Court to provide greater detail on the plain and ordinary meaning of “plate”; rather Asetek is requesting claim construction of the term because of the parties’ disputes over its meaning in view of the written description, prosecution history, and the PTAB’s decision.

Moreover, CoolIT’s untimeliness arguments are disingenuous given that it previously asked the Court to construe the claim term “matingly engaged” in its U.S. 9,057,567 patent after the PTAB issued an adverse final written decision on September 30, 2021, finding all asserted claims of that

1 patent invalid. Specifically, in a hearing before this Court on October 7, 2021, CoolIT’s counsel argued
 2 that because of “the IPR decision that came out last week . . . there is actually an additional claim
 3 construction issue that [] arose because of the IPR” and that the Court “will have to address that claim
 4 construction dispute” regarding the term “matingly engaged.”¹ Ex. D at 35:4-19. In response, the Court
 5 noted that “[i]f something is absolutely necessary, the Court will do it” if the Court “is convinced” that
 6 it is necessary. *Id.* at 35:20-23. For CoolIT to now argue that Asetek should have raised the issue of
 7 claim construction of “plate” during the earlier claim construction stages, not after the PTAB’s
 8 decision, is hypocritical and baseless. Just like CoolIT’s counsel’s argument that an “additional claim
 9 construction issue” of “matingly engaged” “arose because of the IPR” against the ’567 patent, the
 10 “additional claim construction issue” of “plate” similarly “arose because of the IPR” against the ’266
 11 patent. *See id.* at 35:4-19. Ultimately, the Court declined to move forward with CoolIT’s ’567 patent
 12 because all asserted claims in that patent were found invalid by the PTAB. *Id.* at 36:6-37:24.

13 **C. Claim Construction of “Plate” Should Not Be Left for the Jury to Decide**

14 While it may be proper for parties to introduce evidence of the plain and ordinary meaning of
 15 claim terms not construed by the court at trial, here the dispute is not one of plain and ordinary
 16 meaning. Rather, Asetek’s position is that “plate” should be construed based on the written description,
 17 prosecution history, and the PTAB’s decision. If claim construction of “plate” is left unanswered, the
 18 parties would have to introduce the extensive intrinsic evidence (i.e., both the written description and
 19 prosecution history), the PTAB’s decision, and CoolIT’s extrinsic evidence to the jury to argue
 20 infringement/non-infringement, which would amount to improper claim construction before the jury.
 21 *MediaTek, Inc. v. Freescale Semiconductor, Inc.*, No. 11–CV–5341 YGR, 2014 WL 971765, at *5
 22 (N.D. Cal. Mar. 5, 2014) (“[T]estimony grounded in the prosecution history to discern the meaning of
 23 a claim is properly excluded from presentation to the jury. . . . Similarly, while the court may, in its
 24 discretion, consider extrinsic evidence . . . such evidence, if required, is not appropriate for
 25 presentation to a jury and is properly excluded at trial.”). Thus, contrary to CoolIT’s arguments, the
 26 proper meaning and scope of “plate” should be decided by the Court so that the jury is not confused
 27 by competing expert testimony that delves too deeply into claim construction. *Apple, Inc. v. Samsung*
 28

¹ This term was incorrectly transcribed as “mainly engaged.” Bhattacharyya Decl., ¶8.

1 *Elecs. Co.*, No. 12-CV-00630-LHK, 2014 WL 660857, at *3 (N.D. Cal. Feb. 20, 2014) (“Arguing
2 claim construction to the jury is inappropriate because it risks confusion and the likelihood that a jury
3 will render a verdict not supported by substantial evidence.”).

4 **D. Asetek’s Proposed Claim Construction is Supported by the Written Description,
5 the Prosecution History, and the PTAB’s Decision; CoolIT’s Broad Plain and
6 Ordinary Meaning Interpretation Based Only on Extrinsic Evidence is Not**

7 **1. Material is an important defining characteristic of the “plate”**

8 CoolIT argues that the plain meaning of “plate” is defined by “its structure, relationship to
9 other components, and function, not by a material it is made of.” Dkt. 423 at 15. CoolIT is incorrect
10 that material is unimportant in defining the “plate.” Asetek does not disagree that the “plate” is a flat
11 structure (as evidenced by Asetek’s proposed construction of “plate” as “flat manifold body made of
12 a compliant material”). Dkt. 394 at 7. But as explained in Asetek’s summary judgment motion, *the*
13 *rigid vs. compliant material is an important defining characteristic that limits the scope of the term*
14 *“plate” in the context of CoolIT patents. Id.* at 11-13. Specifically, CoolIT’s 2011 Provisional
15 explicitly contrasted the rigid plate 240 disclosed in the 2007 Provisional with the compliant manifold
16 body (i.e., compliant insert 334) first disclosed in the 2011 Provisional, and touted the benefits of
17 compliant over rigid materials. *Id.* at 11-12. In CoolIT’s ’266 patent, which claims priority to the 2011
18 Provisional, CoolIT again distinguished the earlier-disclosed rigid plate 240 from the new compliant
19 insert 334. *Id.* at 12-13. Based on these disclosures in CoolIT’s later publications, *the PTAB found*
20 *that plate 240, which is the only written description for the term “plate” anywhere in CoolIT’s*
21 *patents, is “made of a rigid, rather than compliant, material.”* Dkt. 394-5 at 25-26. Thus, CoolIT’s
22 statement that the “intrinsic record does not specify a material requirement in any of the Asserted
23 CoolIT Patents” is incorrect. Dkt. 423 at 16. The specifications of the CoolIT patents, plus the
24 prosecution histories of the patents (*see* Dkt. 394 at 14-15), specify that plate 240 (i.e., the “plate”) is
25 rigid. CoolIT cannot now argue that the rigid vs. compliant material characteristic is unimportant in
26 distinguishing the claimed “plate” from the later-disclosed compliant manifold body, or that “plate”
should be construed so broadly that it covers both rigid and compliant plates.

27 Nevertheless, CoolIT attempts to rely on extrinsic evidence alone to argue that the material of
28 the “plate” need not be considered. Dkt. 423 at 16-18. Specifically, CoolIT relies on its expert’s

1 declaration (submitted with CoolIT's opposition), multiple textbooks and dictionary definitions, and
 2 the plain meaning definition of "plate" in other unrelated court decisions to argue that the "plate's
 3 material was not a critical feature" of CoolIT's invention, that "the intrinsic record does not specify a
 4 material requirement," and that "plate" should be defined only by its structure. *Id.* at 16-18. However,
 5 CoolIT's same expert argued in the IPR that the patent disclosure teaches a "few material choices"
 6 and that a skilled would likely choose a non-rigid (compliant) material for plate 240, which contradicts
 7 his present position that there is no material requirement for "plate." Ex. E at 52:2-54:19. CoolIT
 8 further identifies "scientific articles, patents, and publications" to argue that "non-rigid plates" were
 9 known in the art prior to CoolIT's alleged invention date of August 2007. Dkt. 423 at 17-18. But
 10 whether "non-rigid plates" were known before August 2007 does not address whether the inventor
 11 possessed a "plate" made from a compliant (non-rigid) material by the time of the invention, and thus
 12 whether there is written description support for "plate" made of compliant (non-rigid) material. And
 13 the PTAB unequivocally found based on the intrinsic record that there was no such written description.
 14 *See* Dkt. 394-5 at 23, 26, 30. And accordingly, "plate" cannot be broadly construed to encompass
 15 compliant materials as urged by CoolIT.

16 Importantly, CoolIT's elevation of extrinsic evidence over the intrinsic record of the patents is
 17 contrary to fundamental principles of claim construction. As the Federal Circuit explained in *Phillips*
 18 *v. AWH Corp.*, "extrinsic evidence in general [is] less reliable than the patent and its prosecution
 19 history in determining how to read claim terms," and that "a court should discount any expert
 20 testimony that is clearly at odds with the claim construction mandated by the claims themselves, the
 21 written description, and the prosecution history, in other words, with the written record of the patent."
 22 415 F.3d 1303, 1318 (Fed. Cir. 2005) (citation and quotation marks omitted). As the Federal Circuit
 23 additionally explained in the seminal *Vitronics Corp. v. Conceptronic, Inc.* case, "[i]n most situations,
 24 an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such
 25 circumstances, it is *improper to rely on extrinsic evidence*. In those cases where the public record
 26 unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is
 27 improper." 90 F.3d 1576, 1583 (Fed. Cir. 1996) (citations omitted and emphasis added). That is the
 28 case here, where the intrinsic record unambiguously establishes the importance of the rigid vs.

compliant material characteristic of the claimed “plate.” Therefore, the Court should not rely on CoolIT’s litigation-driven extrinsic evidence, which contradicts the intrinsic evidence, to find that the “plate” should not be defined by its material.

2. The intrinsic record and the PTAB’s final decision support Asetek’s proposed construction of “plate” as requiring rigid materials

CoolIT blatantly mischaracterizes the PTAB’s final decision in the IPR against its ’266 patent to argue that the decision is not relevant to the claim construction of “plate.” Dkt. 423 at 19-20. CoolIT’s argument that the PTAB did not construe the term “plate,” and based its priority determination on the phrase “manifold body defin[ing] a pair of compliant surfaces,”² ignores that in order to show benefit of priority to the alleged 2007 date invention—which required CoolIT to show written description support for a manifold body made of compliant materials in the 2007 Provisional—CoolIT argued to the Board that “the inventor possessed a plate 240 made from a compliant material by August 9, 2007” and that the disclosure in the 2007 Provisional was “consistent with plate 240 being made from a compliant material.” Dkt. 394-11 at 21-28. But the PTAB rejected each of these arguments, in which CoolIT attempted but failed to show that plate 240 was made of a compliant material. Dkt. 394-5 at 24-29. The PTAB instead agreed with Asetek that there was no written description support for a plate made of compliant material in the 2007 Provisional. *Id.* at 23, 30; *see also* Dkt. 394 at 2-3 (identifying the PTAB’s specific findings). Indeed, the PTAB specifically found that the 2007 Provisional provided written description support only for a plate made of rigid material. Dkt. 394-5 at 24-29. But now in this case, in which CoolIT is asserting patents that claim priority to the 2007 Provisional (which discloses only a rigid plate), CoolIT is improperly attempting to construe the claimed “plate” more broadly, and beyond the written description, to include plates made of compliant materials. In so doing, CoolIT is trying to improperly capture compliant material subject matter, disclosed for the first time in 2011, into the scope of its earlier-filed patent claims, which is impermissible. *See PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1309-11 (Fed. Cir. 2008).

² A “manifold body defin[ing] a pair of compliant surfaces” is the same as a manifold body made of a compliant material. Bhattacharyya Decl., ¶9. Even CoolIT does not argue otherwise (nor can it). *See* Dkt. 394-11 at 21 (CoolIT arguing that the priority challenge reduces to whether “the inventor had possession of a manifold body made from a ‘compliant’ material.”).

1 CoolIT's argument that plate 240 is only one embodiment in the '266 specification, and claim
 2 construction should not be limited to that, misses the mark because there is no written disclosure of a
 3 "plate" made of compliant material and the intrinsic record makes a clear distinction between rigid
 4 and compliant materials, as the PTAB found, thus imposing a limit on the scope of the claimed "plate."
 5 See Dkt. 394 at Section II, A. Indeed, it is well established that the scope of the claim cannot exceed
 6 the inventor's disclosure in the specification. See *id.* at 9-11 (discussing cases finding that the claim
 7 scope cannot exceed the written disclosure). ***In order for CoolIT to get a broad interpretation of***
 8 ***"plate" that includes compliant materials, CoolIT must show written description support for "plate"***
 9 ***made of compliant material. But CoolIT cannot do that (and has not even attempted to do that in***
 10 ***its opposition).*** CoolIT tried unsuccessfully to show written description support for "plate" made of
 11 compliant material during the IPR by pointing to its only embodiment—plate 240. But the PTAB
 12 disagreed and expressly found that there is no written description support for plate 240 being made of
 13 a compliant material. See Dkt. 394 at Section II, A. That should be the end of the written description
 14 inquiry. CoolIT's arguments that the terms "plate" and "manifold body" are not interchangeable,³ and
 15 CoolIT's legally erroneous argument that written description inquiry for priority determination is
 16 different from regular written description analysis,⁴ are incorrect and beside the point.

17 The prosecution history of CoolIT's patent further supports limiting the scope of "plate" to
 18 rigid materials. Dkt. 394 at 14-15. CoolIT's attempted spin on the statements in the prosecution
 19 histories is incorrect and mischaracterizes the prosecution histories. By distinguishing Nelson's stiff
 20 and rigid plate 36 from the claimed compliant manifold, CoolIT clearly and unmistakably made the
 21 material of the plate/manifold body an important defining characteristic. CoolIT's express
 22 differentiation of rigid vs. compliant plate during prosecution contradicts its present (incorrect)

23
 24 ³ CoolIT's argument that "plate" and "manifold body" are not interchangeable contradicts its prior attempt
 25 at the PTAB to rely on plate 240 to show support for "manifold body" made of compliant material. Dkt.
 394-11 at 21-28; see also Dkt. 394-5 at 23, 24 (the PTAB equating "manifold body" to "plate").

26 ⁴To claim the benefit of an earlier priority date, the earlier disclosure must meet the written
 27 description requirement under Section 112, ¶1. *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d
 1316, 1326 (Fed. Cir. 2008) ("[A] claim in a later application receives the benefit of the filing date of
 28 an earlier application so long as the disclosure in the earlier application meets the requirements of 35
 U.S.C. § 112, ¶ 1, including the written description requirement, with respect to that claim."); *New
 Railhead Mfg., LLC v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002) (same for a non-
 provisional application to be afforded the priority date of a provisional application).

1 position that “plate” should be construed broadly to include both rigid and compliant materials.

2 **3. CoolIT has not shown written description support for “plate” made of**
 3 **compliant material to support its plain meaning interpretation, nor**
 4 **can it. In any event, CoolIT is collaterally estopped from litigating the**
 5 **written description issue in the district court**

6 As discussed above, CoolIT must show written description support for “plate” made of
 7 compliant material to get a broad plain meaning interpretation of “plate” that includes plates made of
 8 compliant material. CoolIT has not (and cannot) show that. CoolIT asserts that its expert has not had
 9 an opportunity to address written description for “plate” made of compliant material (even though
 10 Asetek addressed its claim construction of “plate,” the written description issue, and related non-
 11 infringement position in Dr. Tuckerman’s Non-Infringement Report served on December 8, 2021).
 12 Dkt. 423 at 23. The truth is that CoolIT (and its expert) had a full and fair opportunity to show written
 13 description for “plate” made of compliant material at the PTAB. It tried and failed. CoolIT should not
 14 be allowed to continue to litigate this same written description issue in this Court. Furthermore, CoolIT
 15 and its expert have had more than four months to consider Dr. Tuckerman’s expert opinion on this
 16 subject, and CoolIT’s expert submitted an expert declaration along with its opposition in an attempt
 17 to thwart Asetek’s motion for summary judgment, but the expert said nothing to attempt to show
 18 written description because it is simply not there, as established previously in the PTAB proceeding.

19 Contrary to CoolIT’s assertion, the identical issue of written description for “plate” made of
 20 compliant material was before the PTAB because there is no distinction between the terms “plate” and
 21 “manifold body” in the context of CoolIT’s patents. *See* fn. 3, *supra*. Specifically, at the PTAB,
 22 CoolIT’s only argument for patentability was that the challenged claims 1, 2, 5, and 9 of the ’266
 23 patent are entitled to the 2007 priority date because the 2007 Provisional allegedly shows that “the
 24 inventor had possession of a manifold body made of compliant material, *namely plate 240*.” Dkt. 394-
 25 5 at 22-23. The PTAB rejected that argument and found there was no written description support for
 26 plate made of compliant material. *Id.* at 23-24.

27 CoolIT’s attempts to distinguish *Zoho Corp. v. Sentius Int’l, LLC*, 494 F. Supp. 3d 693 (N.D.
 28 Cal. 2020) and *Atlantic Research Marketing Systems, Inc. v. Troy*, 659 F.3d 1345 (Fed. Cir. 2011) are
 misplaced. Dkt. 423 at 24. Both of those cases stand for the proposition that there must be written

description support for the *full scope* of the claim. The fact that CoolIT can show support for “plate” made of rigid material (i.e., plate 240) is beside the point. CoolIT has not (and cannot) show written description support for plate made of compliant material, without which “plate” should not be construed broadly to include plates made of compliant material.

II. UNDER THE PROPER CONSTRUCTION OF “PLATE” AS A MANIFOLD BODY MADE OF RIGID MATERIAL, THE COURT SHOULD GRANT SUMMARY JUDGMENT OF NON-INFRINGEMENT FOR ASETEK’S GEN 5, 6, AND 7 PRODUCTS BECAUSE THERE IS NO GENUINE DISPUTE THAT THE ALLEGED “PLATE” IN THESE PRODUCTS IS MADE OF A COMPLIANT MATERIAL

CoolIT argues that there is a dispute between the parties whether the EPDM manifolds in Asetek’s Gen 5, 6, and 7 products “fall[] within the plain meaning of the term ‘plate’ in the context of the claims,” and that the parties should “introduce evidence at trial to illustrate the plain meaning” and have the jury decide infringement. Dkt 423 at 15. But that is not the correct issue. Asetek’s position is that “plate” should be construed by the Court as a manifold body made of rigid (non-compliant) material, and that under that proper construction, the Court should grant summary judgment that Asetek’s Gen 5, 6, and 7 products are non-infringing because there is no dispute of material fact that the EPDM manifolds (i.e., the alleged “plate”) in Asetek’s Gen 5, 6, and 7 products are compliant (non-rigid) and thus fall outside the scope of “plate” as properly construed. Whether CoolIT expert considers the EPDM manifolds as “plate” under its plain and ordinary meaning is not relevant to Asetek’s summary judgment motion.

III. ASETEK’S ALTERNATIVE WRITTEN DESCRIPTION ARGUMENT IS NOT UNTIMELY BECAUSE IT IS PREDICATED ON THE COURT GIVING “PLATE” A BROAD PLAIN MEANING INTERPRETATION

CoolIT cannot legitimately claim any unfair surprise or “harm” from Asetek’s written description-based invalidity argument because the exact same matter—written description for plate made of compliant material—was litigated between the parties in the PTAB. Moreover, Asetek’s invalidity theory is directly driven by claim construction of “plate,” which the Court has not decided yet. Moreover, this invalidity issue arose alongside the issue of claim construction of “plate” following the PTAB’s IPR decision, so Asetek could not have raised it before. In a similar situation, Judge Orrick explained that he is “‘extremely reluctant’ to dispose of substantive invalidity attacks based on procedural defects.” *Huawei*, 340 F. Supp. 3d at 998 (citation omitted). The same should apply here.

IV. DEFENDANTS HAVE FAILED TO IDENTIFY EVIDENCE THAT CLEARLY AND CONVINCINGLY SHOWS THAT A PERSON SKILLED IN THE ART WOULD HAVE BEEN MOTIVATED TO COMBINE THE PRIOR ART REFERENCES IN OBVIOUSNESS GROUNDS 4-9 AND WOULD HAVE REASONABLY EXPECTED SUCCESS IN DOING SO

“In order to survive summary judgment, [Defendants] must provide evidence that, viewed through the lens of summary judgment, clearly and convincingly shows ‘that a person of ordinary skill in the art would have been motivated to combine the prior art in the way claimed by the ’362 patent claims at issue and had a reasonable expectation of success in doing so.’” *Asia Vital Components Co. v. Asetek Danmark A/S*, 377 F. Supp. 3d 990, 1011 (N. D. Cal. 2019) (citing *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 991 (Fed. Cir. 2017)). Here, Defendants have failed to identify evidence that clearly and convincingly shows that a skilled artisan would have been motivated to combine the prior art and would have had a reasonable expectation of success in doing so.

In its summary judgment motion, Asetek pointed out that Dr. Abraham’s obviousness opinions for Grounds 4-9 failed to explain *how* or *why* the prior art references would have been combined to arrive at the ’362 patent claims. Dkt. 394 at 22-25. In response, Defendants do not identify any evidence in the record that explains how the references would have been combined, or why a skilled artisan would pick out the references in Grounds 4-9 and combine them in the manner claimed. *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1353-54 (Fed. Cir. 2014) (requiring “meaningful explanation for why one of ordinary skill in the art would be motivated to combine [the particular] references at the time of this invention.”); *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008) (requiring “motivation to combine particular references to reach the particular claimed method”); *ActiveVideo Networks, Inc. v. Verizon Commc’ns., Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (requiring explanation of “how specific references could be combined . . . or how any specific combination would operate or read on the asserted claims”). Instead, Defendants simply point to ¶¶695, 697, 701-706 in Dr. Abraham’s Invalidity Report (Dkt. 396) that copy-paste paragraphs from Shin, Ryu, Wu, Yu, and Batchelder to show that each reference is “attempting to solve similar issues and each disclose or teach known techniques that can be used for one another.” See Dkt. 396 at ¶¶695, 697, 701-706. Contrary to Defendants’ assertion, however, these paragraphs in the Report do not explain why a skilled artisan would have picked Shin, Ryu, Wu, Yu, and Batchelder

1 (as opposed to other references) to combine in the manner claimed, nor do they explain how a skilled
2 artisan would have combined them and how the proposed combination would have worked.

3 Specifically, Dr. Abraham’s conclusory assertion in these paragraphs that the asserted prior art
4 references are “attempting to solve similar issues” is not legally sufficient to establish a motivation to
5 combine. *Securus Techs., Inc. v. Glob. Tel*Link Corp.*, 701 F. Appx. 971, 977 (Fed. Cir. 2017) (finding
6 the “broad characterization” of the references as falling within the same alleged field, without an
7 explanation of “how or why” they would be combined, was insufficient to support obviousness);
8 *Microsoft Corp. v. Enfish, LLC*, 662 F. App’x 981, 990 (Fed. Cir. 2016) (affirming finding of no
9 motivation to combine where appellant “gave no reason for the motivation of a person of ordinary
10 skill to combine [the two references] except that the references were directed to the same art or same
11 techniques”); *DSS Tech. Mgmt., Inc. v. Apple Inc.*, 885 F.3d 1367, 1374-77 (Fed. Cir. 2018) (mere
12 “similarities” between prior art references not sufficient for motivation to combine). Nor is Dr.
13 Abraham’s assertion that the references “teach known techniques that *can* be used for one another”
14 (emphasis added) legally sufficient because it is a “conclusory reference[] to [his] belief that one of
15 ordinary skill in the art *could* combine these references, not that they *would* have been motivated to
16 do so.” *InTouch Techs.*, 751 F.3d at 1352 (emphases in original); *ActiveVideo*, 694 F.3d at 1327.

17 At bottom, Dr. Abraham’s conclusory, *ipse dixit* opinion that a skilled artisan would have been
18 motivated to combine the references, without explanation of how or why they would have been
19 combined, does not raise genuine issues of material fact. *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d
20 1352, 1359, 1362-63 (Fed. Cir. 2019).

21 But even if the Court were to find a motivation to combine the references in Grounds 4-9 (it
22 should not for the reasons explained above and in Asetek’s opening brief), the obviousness allegations
23 in Grounds 4-9 still fail as a matter of law because Defendants failed to identify legally sufficient
24 evidence that a person skilled in the art would have had a reasonable expectation of success in
25 combining the asserted references. *Novartis Pharms. Corp. v. West-Ward Pharms. Int’l Ltd.*, 923 F.3d
26 1051, 1062-63 (Fed. Cir. 2019) (separating the motivation to combine and reasonable of success
27 inquiries, and affirming finding of no obviousness because the defendant failed to prove reasonable
28 expectation of success by clear and convincing evidence); *MediaTek, Inc. v. Freescale Semiconductor*,

1 *Inc.*, No. 11–CV–5341 YGR, 2014 WL 2854705, at *2 (N.D. Cal. June 20, 2014) (requiring a separate
 2 showing of reasonable expectation of success) (citation omitted); *see also* Dkt. 394 at 25 (citing cases).

3 Defendants simply point to ¶¶ 712-714 of Dr. Abraham’s Invalidity Report (Dkt. 396) to argue
 4 that he identified reasonable expectation of success for Grounds 4-9. Dkt. 423 at 24. But ¶¶ 712-714
 5 simply make conclusory statements that each reference individually is enabled, and that “a POSA []
 6 would have been able to put them together in a known way with predictable results and a reasonable
 7 expectation of success.” Dkt. 396, ¶713. Such a conclusory, single-sentence assertion is not legally
 8 sufficient to clearly and convincingly shows that there would have been a reasonable expectation of
 9 success in combining the references in Grounds 4-9. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d
 10 1364, 1380 (Fed. Cir. 2016) (finding conclusory statements insufficient to prove obviousness); *Asia*
 11 *Vital Components*, 377 F. Supp. 3d at 1011, 1013-14 (finding AVC’s expert’s opinion insufficient
 12 because he did not explain “how combining the prior art references would have resulted in a workable
 13 and smaller device, let alone in the specific invention of the ’362 patent.”); *Broadcom Corp. v. Emulex*
 14 *Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013) (finding that even if there “might have [been] some
 15 motivation . . . the record does not show any reasonable expectation [of success],” and requiring “a
 16 plausible rational[e] as to why the prior art references would have worked together.”) (citation and
 17 quotation omitted). Thus, contrary to Defendants’ argument, there is no factual issue for the jury to
 18 decide regarding reasonable expectation of success for Grounds 4-9. *MediaTek*, 2014 WL 2854705,
 19 at *7-8 (finding Freescale’s expert opinion “entirely too conclusory to create a genuine factual
 20 dispute,” and that “[s]imply arguing against MediaTek’s facts in a summary manner, without evidence
 21 to establish a dispute, does not suffice” to avoid summary judgment of no obviousness).

22 Given that fact and expert discovery have closed, and Defendants failed to present legally
 23 sufficient evidence on motivation to combine and reasonable expectation of success for Grounds 4-9,
 24 summary judgment of no invalidity of claims 17 and 19 of the ’362 patent under Grounds 4-9 is
 25 appropriate. *Asia Vital Components*, 377 F. Supp. 3d at 1014.

1 Dated: April 21, 2022

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